



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,563	12/01/2004	Axel Hinz	PC10452US	5121
23122	7590	04/21/2008		
RATNERPRESTIA			EXAMINER	
P O BOX 980			FRANTZ, JESSICA L	
VALLEY FORGE, PA 19482-0980				
		ART UNIT	PAPER NUMBER	
		3746		
		MAIL DATE	DELIVERY MODE	
		04/21/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/516,563

**Applicant(s)**

HINZ ET AL.

**Examiner**

JESSICA L. FRANTZ

**Art Unit**

3746

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/20/2008 has been entered.

2. This Action is in response to the Amendment filed 10/1/2007. Currently claims 11-20 are pending in this application.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-17 rejected under 35 U.S.C. 102(b) as being anticipated by Finkbeiner et al. 5,997,262. Finkbeiner teaches the invention as claimed including a motor/pump unit 20 which can be used for slip-controlled motor vehicle brake systems, including an accommodating member 28 for hydraulically active components, an internal gear pump 22 arranged in a bore of the accommodating member and comprising pump components such as a pinion/internal gear combination 64, 68 arranged between two housing parts 60, 72, the pump components forming a pre-assembled unit including a motor 24 for driving the internal gear pump. Furthermore, Finkbeiner teaches a securing element 74 connects the housing parts with a relative clearance to each other

(i.e. the thickness of ring 62), and in that a bore is provided in the accommodating member for the alignment of the housing parts in a radial direction as clearly shown in figure 1. Furthermore, as shown in figure 1 and discussed in Finkbeiner column 8, lines 12-39), a first housing part 72 is fixed on the accommodating member so as to be undisplaceable in an axial direction and in a radial direction, and in that the first housing part is provided to lock the pump components in the accommodating member and wherein a pin 74 with a first end 98 is provided as a securing element which is press fitted into a bore 176, 174 of one of the housing parts, and in that the pin includes a second end 94 with a stop 92 for securing another housing part in position wherein the pin is arranged in parallel to a pump shaft 76. Furthermore, Finkbeiner teaches the pin includes a cylindrical portion 102, which extends through a bore 148 in one of the housing parts, and in that the bore has a diameter that is larger compared to the cylindrical portion, and in that the diameter is smaller compared to the stop (see figure 3) and also that a maximum of three pins (shown with two spaced 180 degree intervals) are provided, and in that the pins are arranged at a regular angle  $\alpha$  relative to each other. Finkbeiner also teaches the internal gear 64 is supported in a ring 62 that is arranged in an axial direction between the housing parts as shown in figure 2 where the pin is supported in bores of the housing parts. In regards to the newly added limitations in the various independent claims that recite "the housing parts are interconnected in a form-locking preassembly having at least a first and second configurations, wherein in the first configuration the housing parts are radially moveable relative to one another and in the second configuration the housing parts are substantially fixed radially relative

Art Unit: 3746

to one another" such a limitations is considered a product by process limitation. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. It is noted, contrary to Applicant's contention that the structure of Finkbeiner is quite capable of performing as such. By only inserting one pin first, the structures may move radially of one another. And once the structure is completely assembled, the final pins are placed and prevent the structures from rotating about one another.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finkbeiner et al. 5,997,262 in view of Pippes et al. WO 02/070898. For Translational purposes please see Pippes et al. 2003/0161748. Finkbeiner teaches the invention as claimed but fails to teach the following claimed limitation as taught by Pippes: a ring 5 which is pivotal relative to the housing parts 11, 12 about a pivot axis (A) (the axis of pin

22) that is arranged in parallel to a pump shaft wherein a housing part accommodates an end of a spring element 25, and in that another end of the spring element is engaged in a bore of the ring positioned in the other housing as clearly shown in figure 3 (both housing hold ring). Pippes teaches the use of the pivot and spring for the purpose of providing a pivotal axis for the ring and for delimiting the pivotal path by a pre-designed measure (see Pippes paragraphs [0024-0025]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the pivot and spring for the purpose of providing a pivotal axis for the ring and for delimiting the pivotal path by a pre-designed measure (see Pippes paragraphs [0024-0025]).

#### ***Response to Arguments***

6. Applicant's arguments filed 2/20/2008 have been fully considered but they are not persuasive. Specifically, as indicated in the above rejection, the bulk of Applicant's arguments are focused on the manner in which the pump is assembled. However, such limitations are merely product by process limitations which are not patentable. Also it is pointed out that the invention of Finkbeiner is capable of completing the process steps. For example, Finkbeiner's housing parts may be connected during the assembly process as a form locking preassembly wherein the parts are radially moveable relative to one another prior to insertion (where there is only one pin assembled, the two housing portions can move relative to one another) and are substantially fixed radially relative to one another after insertion (when the accommodating member locks the structure radially in place or when the rest of the pins are inserted). Please see the above rejection for further description.

7. Applicant is advised that changing the claims to include a process of manufacture might more adequately cover the intended limitations and be given more patentable weight.

### ***Conclusion***

This Action is made **NON-FINAL**. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Frantz whose telephone number is 571-272-5822. The examiner can normally be reached on Monday through Friday 8:30a.m.-5:00p.m. E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/  
Supervisory Patent Examiner, Art  
Unit 3683

Application/Control Number: 10/516,563

Page 7

Art Unit: 3746

/Jessica L Frantz/

Examiner, Art Unit 3746